

67



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,636	03/08/2000	Andrew Casper	105026/002	1455

7590 08/01/2005
 Stroock & Stroock & Lavan LLP
 180 Madison Lane
 New York, NY 10038

EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/521,636	Applicant(s) CASPER, ANDREW	
	Examiner Frantzy Poinvil	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-10 and 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. After a further search, the Examiner has found new prior art. The Examiner is obliged to apply the prior art. The Examiner regrets the delayed process of the application. The finality of the prior Office action has been withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8-10, 12-19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis (US Patent 6,233,565) considered with Renard (WO 00/02150).

As per claims 1 and 25, Lewis et al discloses:

a purchaser account database for storing therein purchaser account information for each purchaser, the purchaser account information including at least a purchaser identifier for identifying a particular purchaser, payment data for effecting payment of purchased goods or services, and delivery data associated with the purchaser identifier, the delivery data including at least one delivery address of the purchaser for fulfillment of the purchaser order. Note column 5, lines 3-10; column 15, lines 6-36 and column 16, lines 5-40 of Lewis.

a processor for receiving the purchase order from said public network the purchase order including the purchase identifier (figure 3 and column 4, lines 53-60);

wherein the purchase identifier is any alpha-numeric code that is different from the payment data (column 25, lines 1-15)

wherein in response to receipt of the purchase order including the purchaser identifier; the processor retrieves the payment data and the delivery data from the purchaser account database corresponding to the purchaser identifier, transmits the delivery data to the merchant to fulfill the purchase order, and uses the payment data to pay for the purchased goods or services without exposing the payment data to the merchant (column 4, line 53 to column 5, line 2).

Lewis et al teaches disabling the purchaser identifier (column 3, lines 38-42) in response to a fraud not to a specific fraud such as the delivery data associated with a particular purchaser identifier.

The purchaser identifier can be any type of purchaser identifier such as a purchaser's name, identification or tracking number. The payment data can be viewed as the purchased amount and card payment data. Thus purchaser identifiers are different from payment data. The processor is capable of communication with the purchaser account database with a private network and further capable of communication with a public network with a merchant system.

Applicant has amended the claims to recite "wherein the purchaser identifier is generated by the processing system storage of the delivery data in the purchaser account database and is inextricably linked to the delivery data such that any change or attempted change to the delivery data will render the purchaser identifier inoperable" or unusable. It is noted that Lewis does not explicitly state such a limitation. However, it is well known in the art that in many central system and/or financial system, purchasers' card identification, addresses both Email and physical address, names are usually stored therein.

Renard teaches that during a financial transaction between a purchaser and a merchant, a purchaser's address card identification is matched with that stored in the card's provider to note any possible changes. If there are any changes, the transaction is declined. See the abstract pages 3-10 of Renard. Thus, purchaser's card identifier is inextricably linked to an address of the card owner. Combining Lewis with Renard et al would have been obvious to the skilled

Art Unit: 3628

artisan for fraud prevention purposes. As noted above, the purchaser's identification can also be computer generated tracking number being generated during a purchase transaction.

As per claims 2-5, delivery addresses such as E-mail and physical addresses being associated with a purchase identifier are well known in the art. Having such in Lewis and Renard would have been obvious to one of ordinary skill in the art in order to assure the goods/services and documents are delivered at a proper address.

As per claims 8-10, the systems of Lewis and Renard et al do not explicitly state a teach the disabler is operatively connected to the securitizer and the purchaser account information, the securitizer monitoring the processing system and determining if any alterations to the delivery data being attempted and outputting a trigger to the disabler if the alteration are attempted and the disabler disabling the particular purchase account information in response to the trigger. The claimed functions are performed by Renard. See pages 14-18 of Renard. Such would have been obvious to one of ordinary skill in the art with the motivation of providing a secure network in order to encourage consumer's loyalty to the system.

As per claims 12-13, the merchant catalog would have been any types of catalog.

Claims 14 and 17 are similar in scope and contains features addressed in claim 1, and therefore are rejected under a similar rationale.

As per claims 15 and 16, it would have been obvious to one of ordinary skill in the art to have the system of Lewis and Renard being operated by any types of service providers such as a credit card company or a financial institution for profit purposes.

As per claim 18, determining whether the identified purchaser can pay for the purchased product and if the purchaser is not capable of paying canceling the purchaser order would have

Art Unit: 3628

been obvious to one of ordinary skill in the art at the time the invention was made in order to assure that payment is made for a purchased item.

As per claim 19, invalidating the purchaser identifier if the delivery data is altered would have been obvious to one of ordinary skill in the art for security purposes.

4. Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Egendorf (US Patent No. 6,188,994) considered with Renard (WO 00/02150) and Walker et al. (US Patent No. 5,794,207).

As per 20, Egendorf discloses a method and apparatus for Internet based financial transaction. Note the abstract. The system and method comprise:

At a purchaser system, having access to a merchant store system (column 4, lines 40-47):
selecting a product offered for sale by the merchant, the product being associated with a product identifier (column 5, lines 20-32)

transmitting a purchaser identifier from the purchaser system to the merchant store system (which is an inherent feature in Egendorf);

at the merchant store system

receiving the purchaser identifier (column 5, lines 20-32 and lines 63-67);

generating a purchase order for the selected product that includes the purchaser identifier (column 5, lines 20-32 and lines 63-67); and

communicating the purchase order to the processing system (column 6, lines 15-39) and

at the processing system

processing the purchase order to retrieve delivery data and payment data associated with the purchase identifier

wherein the purchaser identifier is any-alphanumeric code that is different from the payment data (column 5, lines 24-32);

effectuating payment for the selected product without exposing the payment data to the merchant (column 6, lines 15-39 column 2, lines 44-52).

At the processing system or service provider, processing the purchase order to retrieve delivery data and communicating the delivery data corresponding to the purchaser identifier to the merchant is not explicitly stated. However, it is noted that Egendorf discloses that all information including delivery data may be extracted from the customer purchase order which may be communicated to the merchant for verification purposes. Note column 5, lines 20-24 of Egendorf. Communicating the delivery data to the merchant would have been obvious to one of ordinary skill in the art in order to assure that the purchased goods/products are delivered to the correct recipient at the customer's address for security purposes.

The purchaser identifier can be any type of purchaser identifier such as a purchaser's name, identification or tracking number. The payment data can be viewed as the purchased amount and card payment data. Thus purchaser identifiers are different from payment data. The processor is capable of communication with the purchaser account database with a private network and further capable of communication with a public network with a merchant system.

As per the feature of "wherein the purchaser identifier is inextricably linked to the delivery data such that if the delivery data is changed or attempted to be changed the purchaser identifier will be render unusable", it is noted that Egendorf does not explicitly state such a limitation. However, it is well known in the art that in many central system and/or financial system, purchasers' card identification, addresses both Email and physical address, names are usually stored therein. Renard teaches that during a financial transaction between a purchaser and a merchant, a purchaser's address card identification is matched with that stored in the card's provider to note any possible changes. If there are any changes, the transaction is declined. See pages 5-18 of Renard. Thus, the purchaser's card identifier is inextricably linked to an address of the card owner. Combining Egendorf with Renard would have been obvious to the skilled artisan for fraud prevention purposes. As noted above, the purchaser's identification can also be computer generated tracking number being generated during a purchase transaction. Walker et al provide these well-known teachings. See column 8, line 66 to column 9, line 30 and column 13, lines 1-9 of Walker et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker et al in the combination of

Art Unit: 3628

Egendorf and Renard. The motivation would have been to extend the prevention of fraudulent transactions from occurring.

As per claim 21, the teachings of Egendorf, Renard and Walker et al are discussed above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to prevent a purchaser from changing the delivery data in order to prevent intruders from breaking the purchasing system.

Claim 22 contains features recited in claim 20 and these features are rejected under a similar rationale. See also Egendorf as discussed above. Claim 22 further recites "wherein once the secure consumer account is established by the consumer and the unique consumer identifier is assigned to the consumer account, the at least one delivery address associated with the unique consumer identifier cannot be changed without causing the unique consumer identifier to be disabled". Egendorf does not explicitly teach this feature. As per this feature, the Examiner asserts that consumer identifiers are usually a unique identification that should not be changed for security purposes. If the delivery address is changed, causing the unique consumer identifier to be disabled would have been obvious to the skilled artisan.

Furthermore, Renard teaches that during a financial transaction between a purchaser and a merchant, a purchaser's address card identification is matched with that stored in the card's provider database to note any possible changes. If there are any changes, the transaction is declined. See pages 4-18 of Renard. Thus, the purchaser's card identifier is linked to an address of the card owner. Combining Renard with Egendorf would have been obvious to the skilled artisan for fraud prevention purposes. As noted above, the purchaser's identification can also be computer generated tracking number being generated during a purchase transaction. Walker et al provide these well-known teachings. See column 8, line 66 to column 9, line 30 and column 13, lines 1-9 of Walker et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker et al in the combination of Egendorf and Renard order to link a purchase identifier with a delivery address of a card owner. The motivation would have been to prevent fraudulent transactions from occurring.

As per claim 23, it would have been obvious to one of ordinary skill in the art to note that if the delivery is changed and the unique consumer identifier is disabled, the consumer must be issued a new unique consumer identifier prior to making a purchase using the secure consumer account stored on the purchasing system in order to allow a consumer transaction to take place wherein the consumer or the consumer's account is known in the overall system.

As per claim 24, storing only a single address in the secure consumer account such that purchased items can only be delivered to the single delivery address would have been obvious to one of ordinary skill in the art with the motivation of knowing when tampering with the system is being effected or when an unauthorized transaction is being performed in the system.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FP

June 13, 2005


FRANTZY POINVIL
PATENT EXAMINER
Au 3628